

REMARKS

Claims 13-24 are pending. Claims 13, 17 and 21 were amended to improve their form. Claim 21 was also amended to address the claim rejection under 35 U.S.C. § 112, second paragraph. Claims 1-12 were canceled as being directed to a non-elected invention. Withdrawal of the outstanding rejections is respectfully requested for at least the reasons set forth below.

Request for Interview Prior to Formal Action on Amendment

Applicants request an interview prior to formal action on this response. An "Applicant Initiated Interview Request Form" accompanies this response. Please contact Applicants' undersigned representative to schedule the interview.

Request for Consideration of Supplemental Information Disclosure Statement (IDS)

A Supplemental IDS was filed on August 8, 2006. Consideration of the Supplemental IDS is respectfully requested in the next Office Action.

35 U.S.C. § 101 rejection

Claims 13, 17 and 21 were rejected for allegedly being directed to non-statutory subject matter. More specifically, claims 13, 17 and 21 were rejected as being directed to software, per se, lacking storage on a medium which enables any underlying functionality to occur. Applicants respectfully traverse this rejection.

Claim 17, which reads as follows, explicitly recites an article of manufacture...that comprises a storage medium (i.e., computer-readable medium holding computer-executable instructions) which enables the underlying functionality to occur:

17. An article of manufacture for constructing a web page that allows for syndication of digital assets, the article of manufacture comprising a

computer-readable medium holding computer-executable instructions for performing a method comprising:

- (a) constructing a web page; and
- (b) inserting into the web page script associated with at least one digital asset that is desired to be part of a fully rendered web page, wherein the script, when executed by a browser, requests the content of the digital asset from a remote site, the request including a uniform resource identifier (URI) of the web page and a unique identifier of the selected content. (underlining added for emphasis)

Thus, at least claim 17 is patentable even under the Examiner's asserted standard.

Regarding claims 13 and 21, there is no prohibition under 35 U.S.C. § 101 against claims directed to software, per se, or against claims directed to software, per se, that do not explicitly recite a storage medium which enables its underlying functionality to occur. Thus, the Examiner's asserted standard cannot be used to rejection any of the pending claims.

The USPTO published "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" (OG Notices: 22 November 2005)¹. Section IV, pages 19-20 of the guidelines provide the following instructions:

To satisfy section 101 requirements, the claim must be for a practical application of the Sec. 101 judicial exception, which can be identified in various ways:

- (1) The claimed invention "transforms" an article or physical object to a different state or thing.
- (2) The claimed invention otherwise produces a useful, concrete and tangible result, based on the factors discussed below.

a. Practical Application by Physical Transformation

The examiner first shall review the claim and determine if it provides a transformation or reduction of an article to a different state or thing. If the examiner finds such a transformation or reduction, the examiner shall end the inquiry and find that the claim meets the statutory requirement of 35

¹ The attached Appendix includes Section IV of the Guidelines." See, especially, pages 19-23.

U.S.C. Sec. 101. If the examiner does not find such a transformation or reduction, the examiner has not determined as a final matter that the claim is non-statutory. The examiner must proceed in further inquiry.

b. Practical Application That Produces a Useful, Concrete, and Tangible Result
(see guidelines for section b excerpts)

Here, claims 13 and 21 recite a specific set of steps or corresponding apparatus for constructing a web page that allows for syndication of digital assets, as defined in the respective preambles of the claims. Claims 13 and 21 recite a step or means for constructing a web page, and a step or means for inserting into the web page script associated with at least one digital asset that is desired to be part of a fully rendered web page, wherein the script, when executed by a browser, requests the content of the digital asset from a remote site, the request including a uniform resource identifier (URI) of the web page and a unique identifier of the selected content. There is clearly a transformation or reduction of articles to a different state or thing (i.e., the web page in clause (a) is modified as recited in clause (b)). Accordingly, the present invention clearly meets the test for patentability under the “Practical Application by Physical Transformation” test.

Claims 13 and 21 clearly meet the test for patentability under the “useful, concrete, and tangible result” test.

(1) Useful result: The claims recite a practical application (i.e., constructing a web page) that has a useful result (i.e., the web page allows for syndication of digital assets).

(2) Tangible result: The claims change articles or materials to a different state or thing. Here, the constructed web page is physically transformed to a web page with inserted script. Furthermore, the claims set forth a practical application that produces a real-world result (i.e., a specific type of web page is constructed). There is nothing merely “abstract” about the recited steps and elements.

(3) Concrete result: The claims recite a process that has a result that can be substantially repeatable and will substantially produce the same result each time that it is performed. Here, a web page that is constructed in accordance with the recited steps and apparatus will always become constructed in the claimed manner each time that the recited steps are performed or the apparatus is constructed.

Furthermore, claims 13 and 21 do not seek protection for any mathematical formula, phenomena of nature, mental process, or abstract intellectual concept.

In sum, claims 13 and 21 clearly meet the USPTO guidelines for patentable subject matter.

Rejections under 35 U.S.C. § 112, second paragraph

Claim 21 was rejected for allegedly “omitting essential cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections.” More specifically, the Examiner asserts that the recited means do not “correspond to well-defined structure of a computer or computer component implemented in either hardware or software and its associated hardware platform.

Regarding the alleged omission of necessary structural connections, claim 21 was amended to more explicitly recite the structural connection between the means in clauses (a) and (b). Regarding the assertion that the means does not correspond to “well-defined structure of a computer...,” claim 21 was amended to clarify that it is directed to a “computer-implemented” apparatus comprising the two claimed means, as fully supported by page 15, lines 19-21 of the present specification which reads as follows (underlining added for emphasis):

The present invention may be implemented with any combination of hardware and software. If implemented as a computer-implemented apparatus, the present invention is implemented using means for performing all of the steps and functions described above.

Applicants have carefully reviewed MPEP § 2172.01 and believe that amended claim 21 fully complies with the interrelationship requirement described therein.

Rejections under 35 U.S.C. § 102

1. Patentability of claims 13-24 over Pettersen

All pending claims were rejected under 35 U.S.C. § 102(e) as allegedly being anticipated

by Pettersen. Applicants respectfully traverse this rejection.

Applicants present a "Declaration of Prior Invention to Overcome Cited Patent" under 37 CFR § 1.131 to swear behind the earliest effective date of Pettersen, which is July 15, 2000, the filing date of Pettersen's patent application.

The Declaration paperwork is self-explanatory. However, to briefly summarize the paperwork, it establishes that the claimed invention was reduced to practice prior to the earliest effective date of Pettersen. Prior to July 15, 2000, and as evidenced by the Declaration exhibits, the software code for Applicants' presently invention was completed and detailed instructions for using the software code to perform the presently claimed invention were created. In view of the Declaration, withdrawal of the rejection over Pettersen is respectfully requested.

Conclusion

Insofar as the Examiner's rejections were fully addressed, the instant application is in condition for allowance. A Notice of Allowability of all pending claims is therefore earnestly solicited.

Respectfully submitted,

RICHARD D. MARTIN et al.

Jan. 4, 2007
(Date)

By: Clark Jablon
CLARK A. JABLON
Registration No. 35,039
AKIN GUMP STRAUSS HAUER & FELD LLP
One Commerce Square
2005 Market Street - Suite 2200
Philadelphia, PA 19103
Telephone: (215) 965-1200
Direct Dial: (215) 965-1293
Facsimile: (215) 965-1210

Enclosure (Appendix – pages 1 and 11-24 of "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" (OG Notice: 22 November 2005))